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Paper No. 13

In re Application of :  
Melvin Hatch : DECISION ON PETITION  
Application No. 09/941,029 :  
Filed: August 28, 2001 :  
Attorney Docket No. NM Tech 8 :

This is a decision on the petition filed by on October 31, 2003 by which petitioner requests supervisory review of the examiner's refusal to enter the proposed drawing correction filed on April 15, 2003 as containing prohibited new matter. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

Initially, it is noted that this petition is technically not timely filed within the meaning of 37 CFR 1.181(f). The action complained of is not the examiner's indication that the appeal brief filed on September 24, 2003 raises an issue that is proper for petition, and therefore, improper for consideration by the Board of Patent Appeals and Interferences on appeal. Rather, the action complained of is the examiner's refusal to enter the proposed drawing corrections filed as part of paper No. 6. The refusal to enter the proposed drawing corrections occurred on April 25, 2003, as part of paper No. 7, the examiner's advisory action. Clearly this petition was filed more than two months after the examiner's refusal to enter the drawing corrections. However, as the application is under appeal and it appears to be petitioner's intention to proceed with the appeal, the petition will be treated on its merits (note that 37 CFR 1.181(f) says that a petition filed more than two months after the action complained of "may" be dismissed as being untimely filed).

Petitioner alleges that the proposed drawing correction filed on April 15, 2003, a copy of which is attached to the petition, is fully supported by the original application disclosure, in particular the disclosure found in the specification of the application at the top of page 5. Petitioner, therefore, requests entry of the proposed drawing correction.

A review of this application shows that as originally filed, this application discloses two specific embodiments of a metallic heat conducting support for a round or curved bottom vessel such as a flask, especially a glass flask (specification, pages 4-8). The structure of the support is that an inner portion 21 concavely curved at bottom 22 to compliment the curved lower surface of a curved or round bottom vessel is joined to an outer portion 24. The outer portion extends downwardly from the joint between the inner and outer portions so that the outer portion "surrounds" the inner portion. The outer portion extends towards a supporting base, designated by the reference numeral 26. The base could be formed unitarily with the outer portion (specification, page 4 lines 22-23) or could be formed out of a separate piece of material (specification, page 5, lines 1-3). The base 26 is described as being substantially flat or as having a flat portion, and if formed from a separate piece of material, the base may be continuous or it may have apertures therein, (specification, page 5, lines 6-8). The base is described as having any desired shape, and the two disclosed embodiments differ in that in the Figure 1-2 embodiment, the base is "essentially square" with rounded corners, while in the Figure 3-4 embodiment, the base is circular (specification page 5, lines 8-14). In both embodiments that are specifically disclosed, base 26 is described as being a brim 27 that extends radially outwardly from where the outer portion 24 joins base 26 and provides rigidity and support for base 26. However, the brim 27 is disclosed as "not necessary", and may be eliminated altogether, (specification, page 6 lines 3--15), resulting in base 26 being the lowermost edge of outer portion 24. Brim 27, if used, may be extended as far as necessary, (specification, page 6 lines 3--15).

The examiner first objected to the drawings as originally filed in the examiner's first Office action. The drawings were objected to as failing to illustrate a base having apertures and as failing to illustrate a separately formed base attached to the outer portion (paper No. 3, page 2, first two paragraphs). The basis for the objection was 37 CFR 1.83 which requires, *inter alia*, that the drawing in a nonprovisional application show every feature of the invention specified in the claims. Original claim 8 calls for a base that has apertures, while original claim 10 recites the base as being an element that is separate from, and attached to, an outer portion of the support. In response to the examiner's objection, petitioner filed a proposed drawing correction (part of paper No. 4). However, the examiner refused entry, holding that the correction as proposed contained new matter (paper No. 5, page 2, paragraph 1). The examiner again objected to the drawings under 37 CFR 1.83 and required corrected drawings (paper No. 5, page 2, paragraphs 2-3).

In response to paper No. 5, petitioners submitted the proposed drawing corrections as part of paper No. 6. The examiner held those proposed corrections, which differ from the corrections proposed as part of paper No. 4, to be prohibited new matter, and declined to enter them.

After consideration of the arguments presented in the petition, and the original application disclosure as discussed above, including the original drawings which are not reproduced here but can be understood from the discussion below, it is clear that the drawing correction proposed in paper No. 6 does in fact contain prohibited new matter.

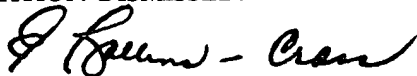
Nowhere in the original specification, claims or drawings is there any illustration of the base 26 as comprising a sheet of material that extends radially inwardly of outer portion 24, and completely beneath inner portion 21 and rounded bottom 22 of the support. Figures 1 and 3 are cross section views of the support taken in a vertical plane running through the center of the support (see Figures 2 and 4), and do not show the support extending radially inwardly of the outer portion 24, let alone beneath inner portion 21 and rounded bottom 22, in the manner illustrated by proposed Figure 1a filed as part of paper No. 6. Indeed, the specification describes base 26 as being the sole necessary "base" (specification, page 6, lines 3-15), or as including brim 27 which extends radially outwardly of the outer portion 24. However, proposed Figure 1a shows what can only be taken as a sheet of material extending completely beneath the support, because the proposed figure is a sectional view, and the element labeled 26 extends beneath the inner portion 21, rounded bottom 22 and outer support member 24 radially inwardly of these elements.

While it is appreciated that brim 27 is described as being "essentially square" or, in a second embodiment, as being "circular", this description does not imply that the brim 27 extends radially inwardly of elements 21, 22 and 24. Clearly, such an interpretation is not the only necessary and reasonable interpretation of petitioner's disclosure. It is equally reasonable, from petitioner's explicit disclosure as a whole, to conclude that base disclosed by petitioner is a radially outwardly extending "brim" that extends outside of outer portion 24 for any desired length, as in United States Patent 4,726,553 (cited in the present record) which shows a member 32 that is not a complete sheet that extends beneath the supported receptacle but is merely a radially outwardly extending flange, notwithstanding the description in USP 4,726,553 of member 52 as being "square." Alternatively, it is clear that petitioner's base 26 may simply consist of the bottom edge of outer portion 24 in a manner similar to the lowermost portion of element 1 of United States Patent 1,651,346 (cited in the present record). But there is absolutely no reason for one of ordinary skill in the art reading petitioner's disclosure to conclude that the base originally disclosed by petitioner is of the form illustrated in proposed Figure 1a that was filed as part of paper No. 6, wherein element 27 extends beneath elements 21 and 22 completely across petitioner's support.

As the drawing correction proposed in paper No. 6 clearly contains prohibited new matter by illustrating brim 27 as an element that extends radially inwardly of outer portion 24 beneath elements 21 and 22 of petitioner's support member, from one side of petitioner's support to the other, it is clear that the examiner did not act in an arbitrary or capricious manner, or abuse his discretion, in holding that the proposed drawing correction filed on April 15, 2003 and refusing to enter the proposed correction for that reason.

Petitioner may file a renewed petition, presenting additional evidence supporting petitioner's contention that the proposed drawing correction filed on April 15, 2003 does not contain new matter. However, the renewed petition must be filed within two months of the date of this decision. See 37 CFR 1.181(f). The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3727 to take appropriate action with respect to the appeal brief filed concurrently with this petition.

PETITION DISMISSED.



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